UNITED STATES PATENT AND TRADEMARK OFFICE

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EXAMINER
DIVINE, LUCAS

ART UNIT	PAPER NUMBER
2624	

DATE MAILED: 08/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	10/002,004	STRUBLE, CHRISTIAN
	Examiner	Art Unit
	Lucas Divine	2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _05 December 2001_.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
   closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _1-25_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _1-25_ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☒ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on _05 December 2001_ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a)☐ All   b)☐ Some * c)☐ None of:

       1.☐ Certified copies of the priority documents have been received.

       2.☐ Certified copies of the priority documents have been received in Application No. _____.

       3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
          application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date _8/27/2004_.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1.   Claim 10 is objected to because of the following informalities: Examiner believes the

processor of claim 10 is the same element claimed as the controller of claim 9 (see Fig. 2

element 104). Appropriate correction is required to resolve any possibility of being unclear on

what is being claimed.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2.   Claims 1, 4, 5, 9, 10, 19, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated

by Yoshida et al. (US 6130757).

Regarding claim 9, Yoshida teaches **an imaging apparatus** (1, 4, or 6, Fig. 2)

comprising:

a user display (touch screen of Fig. 15 is a user display and a user input, shown in other

figures) **configured to present to a user a plurality of retrievable information types** (e.g. TP6

of Fig. 15), **each information type associated with information pertaining to the imaging**

apparatus (the information type [e.g. staple] is used to search the network for information

pertaining to what the local imaging apparatus can access and utilize – Fig. 1 also shows further

information pertaining to the imaging apparatus as accessible and ultizable in the bubble in the

upper right);

a user input (user input OP shown in the figures [e.g. Fig. 3], which includes the touch

screen 91; col. 6 lines 43-46; col. 9 lines 11-13) **to allow the user to select at least one of the**

retrievable information types (Fig. 15 shows the user being able to select functions to search

for and then they are placed in TP7) **and to generate an associated information retrieval**

signal in response thereto (TP8, Fig. 15 shows the button that causes an information retrieval

signal sent to the processors to do the search of the network for the asked for information

associated with the information types selected);

a communication device (50 as controlled by CPU 103, Fig. 2 & 4) **connectable to an**

information network (LAN and PSTN of Fig. 1 is accessed by 50 in Fig. 2 & 4; col. 4 lines 21-

23); **and**

a controller (Fig. 4 shows many controllers [CPUs, e.g. 101-106] for controlling various

parts of the imaging apparatus, as a group, they work to control all functions of the device and

act as a single device controller called CONT [Fig. 2, col. 7 lines 1-5]) **configured to receive the**

information retrieval signal (CPU 101 controls the operation panel, which receives the signals

from the operator panel; col. 7 lines 12-18, col. 12 lines 35-65) **and, in response thereto, to use**

the communication device to retrieve from the information network the associated

information pertaining to the imaging apparatus (CPU 103 controls the network input/output

unit 53 [col. 7 lines 23-35]; col. 6 lines 5-19; Fig. 21 and 22 show the network interactions for

retrieving the information as selected by the user – see *col. 12 line 20 – col. 17 line 5*,

specifically col. 12 lines 54-57).

Regarding claim 10, which depends from claim 9, Yoshida teaches

a memory device (RAMs 121-126 and ROMs 111-116) **containing an information**

retrieval program (col. 2 line 64, col. 7 lines 4-11, wherein the operation of the CPUs are based

on programs stored in RAMs 121-126 and ROMs 111-116); and

wherein the information retrieval program comprises a series of computer

executable instructions configured to be executed by the processor (programs inherently

have instructions and are executed by processors) **to cause the processor to use the**

communication device to retrieve from the information network the associated information

pertaining to the imaging apparatus (CPU 103 [through programs in its ROM 103 and RAM

113] controls the network input/output unit 53 [col. 7 lines 23-35]; col. 6 lines 5-19; Fig. 21 and

22 show the network interactions for retrieving the information as selected by the user – see *col.*

12 line 20 – col. 17 line 5, specifically col. 12 lines 54-57).

Regarding claims 1, 4, and 5, the structural elements of apparatus claims 9 and 10 are the

same as those claimed in apparatus claims 1, 4, and 5. For example, the user input to generate an

information retrieval signal, a communication devise, a processor/controller, and a memory

device are all claimed and taught by the imaging apparatus of Yoshida. Therefore, claims 1, 4,

and 5 are rejected for the same reasons as stated above in the rejection of apparatus claims 9 and

10.

Regarding claims 19 and 22, the structural elements of apparatus claim 9 perform all of

the method steps of method claims 19 and 22. For example, using the communication device to

retrieve information in claim 9 performs the method step of using the signal to initiate a

communication session with an information network of claim 19. Also, the display of Yoshida

shows that the selections are through a **menu** in Fig. 15 as recited the rejection of claim 9.

Therefore, method claims 19 and 22 are rejected for the same reasons set forth in the rejection of

apparatus claim 9.

3.   Claims 1 – 4, 6 – 8, 14 – 16, 18 – 20, and 23 – 25 are rejected under 35 U.S.C. 102(e) as

being unpatentable over Arima (US 6714744).

    Regarding claim 14, Arima teaches in embodiment 2 (Figs. 18 – 21B and col. 8 line 27 –

col. 11 line 56, also descriptions of items embodiment one that do not change from embodiments

[see col. 8 lines 30-32 and the same reference numerals as used in embodiment 1] can be

described elsewhere in Arima) **an imaging apparatus** (block diagram of printing apparatus

shown in Fig. 18) **comprising:**

    a condition detector (detection unit 18B [col. 8 lines 37-51 detects conditions, Fig. 20

S2002] and search unit 18A [take condition and generate search instruction, col. 8 lines 55-59]

combine to act as a condition detector) **configured to generate an information retrieval signal**

(search instruction) **in response to a detected condition** (col. 8 lines 55-59) **within the imaging**

apparatus (detection of expendables in printing apparatus, col. 8 lines 37-39).

    a communication device (communication unit 15A) **connectable to an information**

network (jagged line shown in Fig. 18, Internet discussed col. 10 line 36 and throughout); **and**

    a controller (CPU 1A controls the operations of the printing apparatus, col. 4 lines 53-

54) **configured to receive the information retrieval signal** (col. 11 lines 44-51, the search unit

18A issues the instruction, the CPU controls and transmits the search to the communication unit

15A) **and, in response thereto, to use the communication device to retrieve from the**

information network (communication unit 15A retrieves searched information stored in

provider 15B after the provider searches, col. 10 line 50 – col. 11 line 25) **information**

associated with the detected condition (Fig. 21B is the display of information associated with

the detection conditions).

Regarding claim 15, which depends from claim 14, Arima teaches

a plurality of condition detectors (detections done for plurality of expendables, Fig. 19

19E, each must have its own detector(s)) **each configured to generate a unique information**

retrieval signal (e.g. Fig. 21A, wherein the ink is out and has generated its unique search

information) **in response to an associated detected condition** (col. 8 lines 55-59) **within the**

imaging apparatus (detection of expendables in printing apparatus, col. 8 lines 37-39)**., and**

wherein the controller is further configured to receive the unique information

retrieval signal (col. 11 lines 44-51, the search unit 18A issues the instruction, the CPU controls

and transmits the search to the communication unit 15A) **and, in response thereto, to use the**

communication device to retrieve from the information network (communication unit 15A

retrieves searched information stored in provider 15B after the provider searches, col. 10 line 50

– col. 11 line 25) **information associated with the detected condition** (Fig. 21B is the display

of information associated with the detection conditions).

Regarding claim 16, which depends from claim 14, Arima teaches **the controller is**

further configured to print (with print unit 1C) **the information associated with the detected**

condition (col. 7 lines 52-58 teaches [applicable to all expendable ordering embodiments

including embodiment 2] that a FAX form and/or mail form may be displayed with the searched

information for placing an order and that an order may be placed to a retailer via FAX or mail;

the only way to do so would be to have a printout by the print unit 1C; thus, this feature is

inherent to Arima).

Regarding claim 18, which depends from claim 14, Arima teaches **the imaging**

apparatus further comprises a user display (1D), and the controller is further configured to

display the information (CPU 1A controls the operations of the printing apparatus, col. 4 lines

53-54) **associated with the detected condition using the user display** (Fig. 21B).

Regarding claims 1, 4, and 6, the structural elements of apparatus claim 14 are the same

as those of apparatus claims 1, 4, and 6 except the limitation listed below. Therefore claims 1, 4,

and 6 are rejected for the same reasons set forth in the rejection of claim 14. Further, Arima

teaches **a memory device** (1B, Fig. 18) **containing an information retrieval program**

comprising a series of computer executable instructions (printing apparatus memory

inherently store the programs that are run on the device – controller runs the information

retrieval program shown in Fig. 20 and discussed in the rejection of claim 14).

Regarding claim 2, which depends from claim 1, Arima teaches **a series of computer**

executable instructions to print the information (col. 7 lines 52-58 teaches [applicable to all

expendable ordering embodiments including embodiment 2] that a FAX form and/or mail form

may be displayed with the searched information for placing an order and that an order may be

placed to a retailer via FAX or mail; the only way to do so would be to have a printout by the

print unit 1C; thus, this feature is inherent to Arima).

Regarding claim 3, which depends from claim 1, Arima teaches **a series of computer executable instructions to store the information in the memory device** (col. 6 line 8, wherein the memory 1B can store retailer information, which is what is searched for in embodiment 2).

Regarding claim 7, which depends from claim 6, Arima teaches **imaging apparatus is configured to image sheets of media** (prints on paper 19A)**, and further wherein the condition detector comprises a sheet counter** (Fig. 2 [and its description – counter N counts down], Fig. 3 - Fig. 20, step 2002, wherein expendables are ink, paper, and/or photosensitive body) **configured to count sheets of media imaged by the imaging apparatus** (Fig. 2, Fig. 3).

Regarding claim 8, which depends from claim 6, Arima teaches **imaging apparatus is configured to image sheets of media using an imaging substance** (ink 19A is used to print on paper 19B)**, and further wherein the condition detector is configured to detect a quantity of imaging substance** (Fig. 20, step 2002, wherein expendables are ink, paper, and/or photosensitive body) **used by the imaging apparatus to image sheets of media** (ink 19B is used to print on paper 19A).

Regarding claims 19 and 23, the structural elements of apparatus claim 14 perform all of the method steps of method claims 19 and 23. For example, using the communication device to retrieve information in claim 14 performs the method step of using the signal to initiate a communication session with an information network of claim 19. Further the predetermined amounts are given for example in Fig. 2 of Arima, M is the threshold value. Therefore, method claims 19 and 23 are rejected for the same reasons set forth in the rejection of apparatus claim 14.

Regarding claim 20, which depends from claim 19, the structural elements of apparatus

claim 16 perform all of the method steps of method claim 20. Therefore method claim 20 is

rejected for the same reasons set forth in the rejection of apparatus claim 16.

Regarding claim 24, which depends from claim 23, the structural elements of apparatus

claim 7 perform all of the method steps of method claim 24. Therefore method claim 24 is

rejected for the same reasons set forth in the rejection of apparatus claim 7.

Regarding claim 25, which depends from claim 23, the structural elements of apparatus

claim 7 perform all of the method steps of method claim 25. For example, imaging media are the

sheets used. Therefore method claim 25 is rejected for the same reasons set forth in the rejection

of apparatus claim 7.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

4.   Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshida as

applied to claim 9 above, and further in view of Masuda et al. (US 2001/0008997).

Regarding claim 11, which depends from claim 9, Yoshida teaches to display the

retrieved information (Fig. 16, col. 15 lines 29-31). Yoshida can also access information and

retrieve it from server PC 3 (col. 4 lines 30-32). Yoshida also request information from remote

servers (see step S15 of Fig. 21) and this information can be useful information to the user (col.

14 lines 55-60, wherein telephone number information for faxing is a type of information that

can be requested). Also, Fig. 1 shows that "others" types of information can be retrieved from

the network. These facts and the fact that a user clearly wishes to know the information and has

it displayed, would lead to the motivation that they may want to also print the information for

their own records (for example, printing the phone number information to save for a later date).

Reasons for printing desired information are also very well known in the art. Further, Yoshida

teaches that the client that is doing the information requesting is a copying machine with a

PRINTING unit (Fig. 2, PRT). Therefore, the motivation for being able to print desired

information is clearly put forth in the reference of Yoshida, but the actual statement of printing

the retrieved information is not expressly stated.

However, in paragraph 61, Masuda teaches selecting whether to display or print

information in display device 16, which includes a display and a printer (Fig. 1).

Therefore it would have been obvious to one of ordinary skill in the art to allow the user

to display or print the searched for desired information. The motivations for doing so are

discussed above in the Yoshida discussion.

5.   Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Yoshida as applied to claim 9 above, and further in view of Hayward et al. (US 6629134).

Regarding claims 12 and 13, which depend from claim 9, Yoshida teaches **the memory**

device contains a plurality of network **locators** (Yoshida a system where other devices are

specifically accessed to retrieve information associated with information types selected. By

accessing specific devices to learn their information (Fig. 13, where 3F, 2F, 1F, 2F, 1F are

examples of specific machines accessed), the network addresses of the devices must be known

and stored in memory (RAMs 121-126 and ROMs 111-116 are memory devices of Yoshida).

For example, col. 12 line 56 teaches requesting the other server terminals specifically for their

functions, which must be done with network locators), **and wherein each of the plurality of**

retrievable information types has an associated one of the network locators (Fig. 16, the user

has searched for the types in TP7 of Fig. 15 and has retrieved the devices that have those

functions, therefore each of the three types are at least each associated with the device [and its

identifier], if other types would have been searched, associated devices [and their identifiers]

would have been identified to the user).

Yoshida also teaches that the imaging apparatus can also act as a **server** (col. 4 lines 30-

42, col. 9 lines 15-16). Thus the communication device (CPU 103 and input/output controlling

unit 50) performs the server related functions and thus the **communication device is a server.**

In regards to URL's and web server, Yoshida teaches the accessing of fax, LAN, and the

telephone networks (col. 8 lines 47-60). Yoshida does not specifically teach that the networks

accessed are the Internet or World Wide Web, which use URLs.

However, Hayward specifically teaches accessing the **web** (Fig. 2, Internet 36) for

information pertaining to an imaging apparatus (Fig. 3 shows information types), which must

include URLs in a web environment (col. 1 lines 25-30; col. 2 lines 20-40, wherein specific

URLs are accessed based on printer conditions or selections by a user).

It would have been obvious to one of ordinary skill in the art that the networks of

Yoshida could include the Internet (and associated URLs). The motivation for doing so would

have been to allow the search of many more devices etcetera. Motivations for web use are well

known in the art. Further, Hayward teaches accessing the Internet through modem 34, and since

Yoshida accesses phone networks already, no functional changes would have been necessary.

6.   Claims 17 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arima

as applied to claims 14, 16, and 19 above, and further in view of Kumada (US 6563944).

Regarding claim 17, which depends from claim 16, while Arima teaches

the imaging apparatus is a first imaging apparatus (Fig. 18 shows the first and only

printing apparatus specifically discussed), **and**

the controller is further configured to print the information associated with the

detected condition using the first imaging apparatus (see rejection of claim 16).

Arima does not specifically teach printing on a first printer when possible and if directing

printing to another printer.

Kumada teaches an image processing apparatus and method that automatically selects a

substitute output device including that **the controller is further configured to print the**

information associated with the detected condition using the first imaging apparatus when

the first imaging apparatus is capable of printing the information (Fig. 8, step 108)

and to direct the information to a second imaging apparatus for printing when the

first imaging apparatus is incapable of printing the information (Fig. 8 steps S101-S106,

Fig. 9).

It would have been obvious to one of ordinary skill in the art that if the apparatus of

Arima couldn't print (because possibly the expendable ink is out), to direct the mail/FAX order

form to a substitute printer. The motivation for doing so would have been to perform the

mail/FAX orders even if the local printer can't perform the print, wherein if no alternate printer

was selected, the user couldn't perform the mail/FAX order.

Regarding claim 21, which depends from claim 19, while Arima teaches

the imaging apparatus is a first imaging apparatus (Fig. 18 shows the first and only

printing apparatus specifically discussed), **and**

the controller is further configured to print the information associated with the

detected condition using the first imaging apparatus (see rejection of claim 16).

displaying the information via a user display (Fig. 21B), and

saving the information to a memory location (col. 6 line 8, wherein the memory 1B

can store retailer information, which is what is searched for in embodiment 2). .

Arima does not specifically teach printing on a first printer when possible and if not,

allowing the user to select what to do, including the option of directing printing to another

printer.

Kumada teaches an image processing apparatus and method that automatically selects a

substitute output device including printing on a first printer when possible (Fig. 8, step 108), and

if not, allowing the user to select what to do (Fig. 9, Fig. 8 step 104), including the option of

directing printing to another printer (Fig. 8 steps S105-S106).

It would have been obvious to one of ordinary skill in the art that if the apparatus of

Arima couldn't print (because possibly the expendable ink is out), to let the user chose what to

do next, including the option to direct the mail/FAX order form to a substitute printer. The

motivation for allowing the user to do what they like (be it save the data, display it, or print it

elsewhere) would allow the system to respond better to user needs. There are plenty of possible example when a user would like to do any of these options, and they will not all be recited here, only one example for each. For saving the data: the user would like the data to print out later on the current printer. For displaying the data: the user can't get to an alternate printer and will just copy down the information or memorize it or show it to someone else. For printing on another printer: to perform the mail/FAX orders even if the local printer can't perform the print, wherein if no alternate printer was selected, the user couldn't perform the mail/FAX order.

Conclusion

7.   *Applicant is strongly encouraged to review further portions of Hayward which were not directly cited, which Examiner feels directly and clearly relate to features of applicant's invention.*

8.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

>   US-2002/0030840, Itaki et al., 3-14-2002: teaches image output system, and device and method applicable to the same.

>   US-2002/0027673, Roosen et al., 3-7-2002: teaches scan and print processing in a network system having a plurality of devices.

>   US-6867876, Czyszczewski et al., 3-15-2005 : teaches remote database support in a multifunction office device.
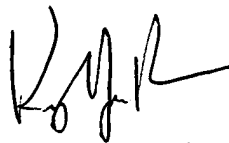
US-5852746, Barrett, 12-22-1998: teaches system for transmitting a message using status button to system administrator by using a signal comprising predetermined number of changes effected over a period.

9.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lucas Divine whose telephone number is 571-272-7432. The examiner can normally be reached on Monday - Friday, 7:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Lucas Divine
Examiner
Art Unit 2624

KING Y. POON
PRIMARY EXAMINER

ljd